

REMARKS

The above Amendments and these Remarks are in reply to the Office Action mailed January 26, 2005. Claims 1-58 were pending in the Application prior to the outstanding Office Action. In the Office Action, the Examiner rejected claims 1-56. The present Response amends claims 1, 2, 4-10, 20-30, 32, 34-37, 39-44, 46, 48-51, 53-58, canceled claims 12-19, 33, 38, 47, and 52, leaving for the Examiner's present consideration claims 1-11, 20-32, 34-37, 39-46, 48-51, and 53-58. All claims are line-numbered as requested by the Examiner. Reconsideration of the rejections is respectfully requested.

CLAIM REJECTIONS UNDER 35 U.S.C. § 112

Claims 1-28 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1,2, 4-10, and 20-28 have been amended to clearly establish the relationship or the antecedent basis between the components referred to the claims. Claims 12-19 have been canceled. Applicants respectfully request that the rejections to these claims based on §112 be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102

Claims 1-6, 9-16, 19-34, 37-48 and 51-58 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Iyer (2001/0037367).

To anticipate a claim, every element of the claim must be disclosed within a single reference. The present invention of providing a state upon request from a message during a conversation as claimed in independent claims 1, 10, 29, 30, 43, 44, 57 and 58 is fundamentally distinguishable from Iyer in following aspects:

- Different communication models. Iyer teaches “sharing of information via a virtual area by multiple parties in a communication network” (page 1, [0002], line 3-5), wherein “The user device is allowed to connect to the shared area and pick up a piece of information for transmission to the user device” (page 1, [0008] line 4-6). Thus it is a model for indirect, many-to-many, message communication among multiple parties via a third party such as the “virtual area.” In contrast, the conversation in the present invention is set up as only “between the first computing device and a conversation partner” (claims 1 and 10, line 3) or the message is received specifically “during a conversation with a conversation partner” (claims 29, 30, 43, 44, 57 and 58, line 5-6). In other words, unlike Iyer, the conversation in our claims is a direct point-to-point message-oriented communication between two parties without any intervening party or event in between. The difference between Iyer and the conversation in the present invention is analogous to that between a message board and a letter or e-mail.
- Different information storage devices. Iyer “stores, in a permanent storage area of the use device, the transmitted information” (page 1, [0008], line 12-13). In contrast, one of the key features of the present invention is to “storing information of the state in memory” (claims 1, line 6, claim 10, line 8, claims 29, 30, 43, 44, 57 and 58, line 4) instead of in a permanent storage only. Such “in memory” storage of state information is important since it gives the present invention “lightweight” characteristics and avoids resource-intensive data lookup to the permanent storage for each message received, as required by Iyer.

Therefore, Iyer cannot anticipate independent claims 1, 10, 29, 30, 43, 44, 57 and 58. Since claims 2-6, 9 depend on claim 1, claims 20-28 depend on claim 10, claims 31, 32, 34, 37, 39-42 depend on claim 29, claims 45, 46, 48, 51, 53-56 depend on claim 43, claims 12-19, 33, 38, 47, and 52 are canceled, Iyer cannot anticipate claims 1-6, 9-16, 19-34, 37-48 and 51-58 for at least this reason, and Applicant respectfully requests that the rejection with respect to these claims be withdrawn..

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

Claims 7, 8, 17, 18, 35, 36, 49 and 50 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Iyer, in view of Eide (2004/0078455).

Prima facie obviousness rejection requires the Examiner to show that the prior art alone or in combination teaches or suggests all elements of the claimed invention. Although not mentioned explicitly, Davis (2004/0158610) is also utilized by the Examiner in the reasoning for rejection under 35 U.S.C. §103(a), so it is also discussed here. Davis teaches “a primary IM processing device configured to forward incoming instant messages to an available secondary IM processing device” and “a storage device accessible to the primary IM storage device configured to capture each instant message sent and received” (page 1, [0005], line 4-9); Eide teaches apparatus “that assists in the distribution of configurations data such as VPD for a switchable resource to multiple nodes within a clustered computer system” (page 1, [0010], line 2-6). Neither of them anticipates providing a state upon request from a message during a conversation between two parties as claimed in the independent claims 1, 10, 29, and 43 in the present invention. Iyer cannot anticipate the present invention either as discussed earlier. Since claims 7 and 8 depend on claim 1, claims 17 and 18 depend on claim 10, claims 35 and

36 depend on claim 29, and claims 49 and 50 depend on claim 43, Iyer in view of neither Davis nor Eide can render the present invention in claims 7, 8, 17, 18, 35, 36, 49 and 50 obvious under 35 U.S.C. § 103(a) for at least this reason, and Applicant respectfully requests that the rejection with respect to these claims be withdrawn.

CONCLUSION

In light of the above, it is respectfully requested that all outstanding rejections be reconsidered and withdrawn. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this reply, including any fee for extension of time, which may be required.

Respectfully submitted,

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